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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/963,423	09/27/2001	Klaus-Peter Jonderko	206033US0	8759

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EXAMINER

SERGEANT, RABON A

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 06/19/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/963,423

Applicant(s)

JONDERKO ET AL.

Examiner

Rabon Sergeant

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-11 and 13-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-11 and 13-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.

- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. Claim 25 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Within claim 25, the language, "blocking any remaining unreacted NCO groups with at least one blocking agent for blocking from 95% to 100% of the NCO groups not reacting with the hydrophilicizing component", is ambiguous, because "any remaining unreacted NCO groups" conflicts with 95+% of the NCO groups not reacting with the hydrophilicizing component.

2. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The significance of the dashes before "sulfonic acids" and "phosphonic acids" is not clear. If the dashes are to denote that the terms are suffixes of "polyhydroxyalkyl", then for purposes of clarity, the complete terms should be set forth.

3. Claims 2-11 and 13-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants claimed percent ranges for the components are unworkable at the claimed upper endpoint of the isocyanate component percent range. For example, at 95% isocyanate content, it is unclear how any component other than hydrophilicizing component can be present.

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4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 2-9, 13, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Farronato et al. ('008).

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Patentees disclose the production of blocked polyisocyanate adducts, which are the reaction product of a polyisocyanate, an active hydrogen compound containing hydrophilic groups, and a blocking agent. See abstract and columns 3-5.

6. Claims 2-11, 13-20, and 22-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Reiff et al. ('370 or '482 or '737).

The references disclose the production of blocked isocyanates, wherein the blocked isocyanates are the reaction product of polyisocyanates, which meet applicants' claimed isocyanates; active hydrogen compounds containing ionic or potential ionic groups, which meet applicants' claimed ionic agents; polyols, which meet applicants' claimed polyols; blocking agents, which meet applicants' claimed blocking agents; and neutralizing agents, which meet applicants' claimed neutralizing agents. See abstract and columns 2-12 within Reiff et al.

7. The examiner has considered applicants' response; however, the position is taken that Reiff et al. disclose an embodiment of the invention, wherein the blocked isocyanate adduct is solid and may be dispersed simply by adding the adduct to water. Patentees further state that dispersion can occur in the absence of solvent. See column 10, lines 16+ within Reiff et al. ('482). See column 11, lines 50+ within Reiff et al. ('370 and '737).

8. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reiff et al. ('370 or '482 or '737) further in view of Lange et al. ('805).

As aforementioned, the references disclose the production hydrophilic group containing, blocked polyisocyanates; however, the references are silent with respect to the addition of

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hydrophobic blocked polyisocyanates. Still, the position is taken that it would have been obvious to incorporate a quantity of hydrophobic, blocked isocyanates into the composition, because the addition of hydrophobic, blocked polyisocyanates to a hydrophilic, blocked polyisocyanate composition was known at the time of invention, as a means of easily incorporating the hydrophobic isocyanate into an aqueous polyurethane forming composition. See column 5 within Lange et al.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (703) 308-2982.


RABON SERGENT
PRIMARY EXAMINER

R. Sergent

June 14, 2003